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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,923	03/01/2004	Nancy C. Frye	063293.0110	1435
5073	7590	10/28/2005	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/790,923

Applicant(s)

FRYE, NANCY C.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election of Species IX; figure 14 in the reply filed on 9/03/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 6, 7, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/3/04.

***Drawings***

3. The drawings were received on 10/26/05. These drawings are not entered because they contain new matter, i.e. the thickness, shape, exact location, etc. of the midsole is considered to be new matter. In response applicants' arguments directed towards the new matter added to the drawings in order to show the midsole, it is noted that it is applicants' responsibility when originally filing the application to ensure that all claimed elements are clearly shown in the drawings, the addition of elements at a later date in most cases does add new matter and will not be entered.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the midsole(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the specification states that 824 is a point at  $\frac{1}{2}$  the length of the shoe, however the point at 824 in figure 14 appears to be clearly in the forefoot portion of the shoe, this is confusing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement

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sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. Claims 2 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 10 in their entirety are functional, vague, indefinite, and incomplete because it is not clear what structural limitations applicant intends to encompass with such language. It is not clear what further structural limitations applicant intends to encompass with such language since there is no further structural limitations recited in these claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 2, 10, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lodispoto (4681114).

9. Claims 1-5, and 10-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Snabb (5491912).

First it is noted that the elected species was first disclosed in parent application 09/688308 filed 10/13/2000 and therefore the subject matter is only given the benefit date of 10/13/2000. Snabb shows a shoe with an upper, insole, and sole (figure 2) with the claimed shape (described in column 3 lines 41-50 and column 4 lines 35-40). In reference to claim 4, the location shown and described by Snabb appears to be the same location shown in applicants' figure 14 and is considered to be "substantially halfway" as claimed.

10. Claims 1, 2, 10, 11, 15, 16, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Robinson (4934073).

Robinson shows a shoe with an upper (34), an insole (30) which is uniformly thick in the toe portion as shown and which has a rear surface which is closer to the outsole (12) which is planar (as shown in the figures), and a midsole (22) as claimed.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1-5, 8, 10-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (4934073).

Robinson shows a shoe with an upper (34), insole (formed by elements 22 and 30), and an outsole 12 substantially as claimed except for the insole be a single piece layer of the shoe. It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally form elements 22 and 30, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

In reference to claims 8, 14, and 16-20, Robinson as modified above shows a shoe substantially as claimed except for a plurality of midsoles located between the insole and outsole. Official notice is taken that the use of midsoles between insoles and outsole is extremely well known and conventional and since applicant has not shown such or provided any detail of such, it is assumed that applicant is claiming a well known and conventional midsole(s). It would have been obvious to provide a midsole(s) in the shoe of Robinson is well known and conventional to increase comfort and cushioning.

13. Claims 8, 14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snabb.

Snabb shows a shoe substantially as claimed except for a plurality of midsoles located between the insole and outsole. Official notice is taken that the use of midsoles between insoles and outsole is extremely well known and conventional and since

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applicant has not shown such or provided any detail of such, it is assumed that applicant is claiming a well known and conventional midsole(s). It would have been obvious to provide a midsole(s) in the shoe of Snabb is well known and conventional to increase comfort and cushioning.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Robinson or Snabb.

Robinson or Snabb as discussed above shows a shoe with an insole substantially as claimed except for the insole being "removable". Official notice is taken that it is well known and conventional to allow insoles to be removable to allow orthotic inserts to be used, insoles and/or shoes to be laundered, to adjust worn elements, etc. It would have been obvious to make the insole removable as is well known and conventional in the shoe of either Robinson or Snabb to provide any of the known benefits of removability as discussed above.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



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16. Claims 1-5, 8, and 10-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,131,315 in view of either Lodispoto, Robinson, or Borgeas (3990159). Patent '315 claims a shoe with a sole which has a uniform thickness in the forefoot and a sloped heel surface to hold the heel lower than the forefoot in relation to the ground surface. Either Lodispoto, Robinson, or Borgeas teaches varying the thickness of an insole layer of the sole to provide sloped surfaces to reorient the foot. It would have been obvious to provide the thickness variation/sloped surfaces in the insole layer as taught by either Lodispoto, Robinson, or Borgeas in the shoe claimed in Patent '315 to allow a prefabricated shoe to be easily adjusted.

#### ***Response to Arguments***

17. Applicant's arguments filed 9/28/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Lodispoto, Lodispoto clearly shows that the insole has a heel portion at number 24 which is thinner than the forefoot portion and therefore the insole clearly has a rear heel surface which is closer to the outsole in the heel area of the outsole than the forefoot (24a) surface. The outsole of Lodispoto is considered to be planar inasmuch as applicant has defined such, i.e. the top surface is shown as planar in figure 5 and therefore the outsole may be considered to be a "planar outsole" as claimed.

In response to applicants' arguments directed towards Snabb, Snabb clearly states that an insole is the layer which has the structure as claimed, this is specifically

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discussed and clearly disclosed in Snabb in column 3 lines 41-50 and column 4 lines 35-40. The flatness argued by applicant clearly refers to the upper surface being flat, not referring to the thickness of the insole as Snabb clearly states that the insole is sloped and that the thickness of the insole varies (for example see column 2 lines 14-60). In reference to figure 2, it appears that this figure merely shown the combination of the insole and the outsole without specifically showing where the two meet. Furthermore it is noted that Snabb clearly states in column 4 lines 50-55 that the slope angle can be adjusted by placing inserts on the inner sole.

In reference to applicants' arguments directed towards Robinson, the insole of Robinson (layer 30) clearly has a "reare heel section" with a surface closer to the outsole (12) than a surface of the forward toe section as shown in the figure. It is noted that claims 1, 2, 10, 11, 15, 16, and 20 do not require any change in thickness of the insole.

In response to applicants' arguments directed towards the Double Patenting rejections, the references clearly suggest modifying the claims of the prior patent to provide the change in slope in the insole instead of other layers of a sole or as a means for adjusting the slope angle of the leg in reference to the foot.

### **Conclusion**

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728



Do Not Enter  
cnp 10/26/05

FIG. 12

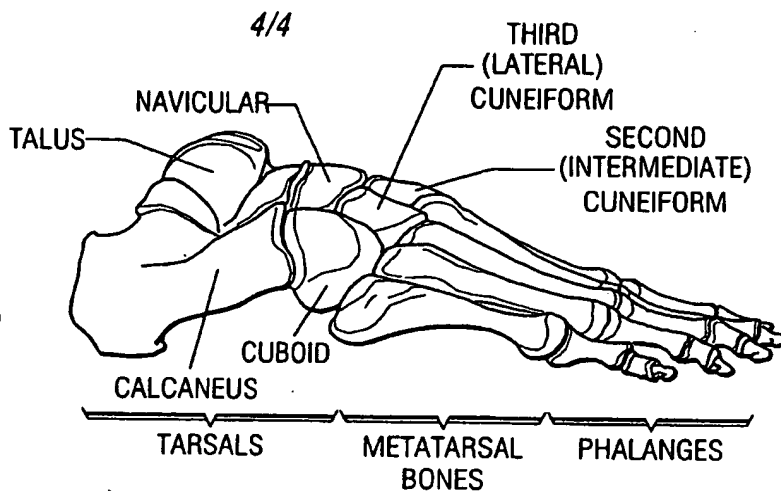


FIG. 13

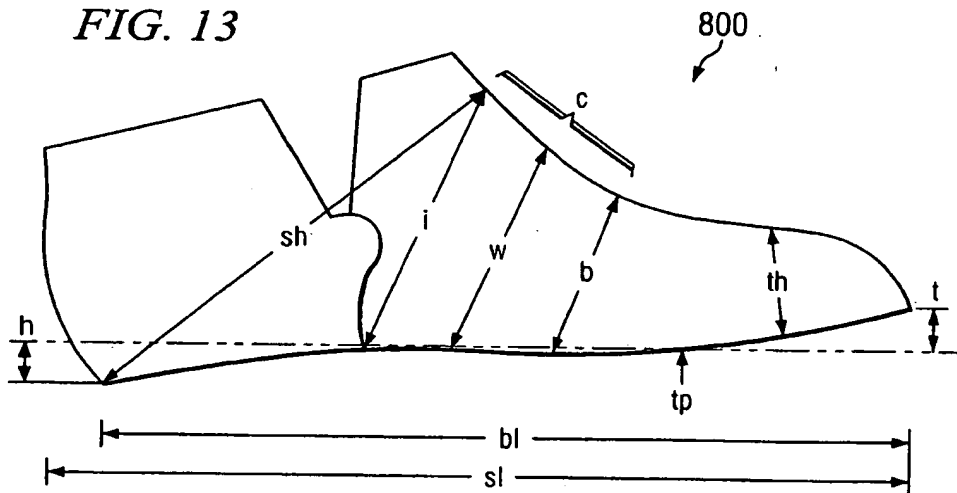


FIG. 14

